

REMARKS

Upon entry of the foregoing amendments, claims 27, 29, 30, and 34-36 are pending in the application. Claims 1-26, 28, 31-33 and 37-55 have been cancelled. Claims 27, 34 and 36 have been amended to further clarify the claimed subject matter. The amendments do not introduce any new matter within the meaning of U.S.C. §132, and the amendments are believed to place the claims in condition for allowance. Therefore, entry of the amendments is respectfully requested.

REJECTION UNDER 35 U.S.C. §112, second paragraph

Claims 4, 28, 38 and 48 have been rejected as indefinite. These claims have been cancelled, thereby rendering the basis of the rejection moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §103(a)

Claims 1, 4-11 and 26-55 are rejected as being unpatentable over Wang et al. in U.S. Patent No. 4,708,820 (the '820 patent), in view of Bezwada et al. in U.S. Patent No. 5,371,176 (the '176 patent) and U.S. Patent No. 4,994,074 (the '074 patent) for reasons of record. Applicants again thank the Examiner for her suggestions regarding the claims and have implemented them in total. For this reason, Applicants respectfully maintain their traversal of this rejection and submit that the amended

claims are not taught or suggested by any combination of the art of record and are therefore allowable.

As discussed during the interview, the art of record does not teach or suggest terpolymer according to the presently amended claims, i.e., a completely amorphous terpolymer consisting essentially of glycolide, ε-caprolactone and trimethylene carbonate and having a glass transition temperature of -40 to 0°C.

Wang is directed solely to the preparation of copolymers, i.e., those derived from two monomers. Applicants are of the position that Wang does not present a suggestion of terpolymers col. 1, lines 7-9, because this language would not be understood as such by one of skill in the art to describe terpolymers due to the use of the term copolymer. Copolymer, as understood in the art, refers to compositions comprised of two monomers. It is well known in the art that compositions comprising more than two monomers do not fall within the meaning of "copolymer" and could only be described in a meaningful way to one of skill in the art using the term terpolymer, etc.

Further, Wang does not teach or suggest the use of only glycolide, ε-caprolactone and trimethylene carbonate as presently claimed. Wang teaches glycolide in an amount of 25-75% and trimethylene carbonate in an amount of 25-75%. No guidance is given to the use or amount of ε-caprolactone. Further, Wang teaches the use of additives such as calcium stearate to improve the product characteristics. In contrast, the present invention

contains glycolide in an amount of about 10-20%, ϵ -caprolactone of about 24-63% and trimethylene carbonate in an amount of about 24-63% and does not require the addition of additives.

Finally, Wang does not suggest the glass transition temperatures presently claimed. Wang states that the glass transition temperatures may be at or below ambient temperature, however no guidance is given to any temperature of less than 0°C. Applicants submit that temperatures above 0°C result in a stiffer product than those having a glass transition temperature less than 0°C. There is no mention of this point in Wang. As such the teaching of less than ambient temperature does not provide a motivation to achieve a product having a glass transition temperature of less than 0°C.

The Bezwada patents do not remedy the deficiencies of Wang. Specifically, neither Bezwada reference teaches the specific terpolymer composition of the present claims. Specifically, the Bezwada patents require additives such as castor oil, glycerol and glycolic acid to improve product characteristics. Furthermore, both Bezwada patents are silent regarding glass transition temperature. Finally, the Bezwada patents do not teach a completely amorphous product, but rather ones which may possess crystallinity.

Bezwada in U.S. 5,371,176 describes terpolymers composed of castor oil, but does not suggest any other monomers, such as trimethylene carbonate. The teachings and suggestions of Bezwada, when combined with Wang, do not

lead to a completely amorphous product of the present claims containing only glycolide, ε-caprolactone and trimethylene carbonate and having a glass transition temperature of 0°C.

Applicants respectfully submit that within the art of record there is no motivation to combine the teachings of Wang with Bezwada to arrive at the presently claimed compositions. One of skill in the art would not be motivated or have a reasonable expectation of success to take the disclosure of Wang and combine it with the Bezwada teachings to arrive at the composition as presently claimed. There is nothing in the references of record that would motivate one of skill in the art to create a terpolymer from only glycolide, ε-caprolactone and trimethylene carbonate, which has a glass transition temperature in the range of -40 to 0°C. Specifically, there is nothing to lead one of skill in the art to take the compositions of Wang and modify them according to the teachings of the Bezwada references to arrive at the presently claimed compositions.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the rejections. Favorable action with an early allowance of all claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Respectfully submitted,

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